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Harmonizing the Tension Between the First Amendment and Publicity Rights and Finding the Right Balance: Discerning How Much Freedom is Warranted and What Needs Protection

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HARMONIZING THE TENSION BETWEEN THE FIRST AMENDMENT AND PUBLICITY RIGHTS AND FINDING THE RIGHT BALANCE: DISCERNING HOW MUCH FREEDOM IS WARRANTED AND WHAT NEEDS PROTECTION

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Abstract

This paper examines the tension between the First Amendment and Publicity Rights considering why and how friction is emerging, the legal underpinnings and theories behind the development of publicity rights and how to reconcile this with values raised in support of the First Amendment. This collision course of rights occurs where property interests have vested in human identity itself which brings us face to face with the outer limits of free speech and expression under the First Amendment and evens tests the notion of how we define speech. The paper takes a dive into some of the currently arising issues with an eye towards future implications, and with concern for the legal uncertainty resulting from the emerging tests being used, inconsistent case law, and the overall landscape shaping this area of law.

INTRODUCTION

"Publicity rights", is an area of the law that tests the very notion of how we define speech, and brings us face to face with the limits of the First Amendment. Human identity itself has become an intellectual property right that can be cultivated and exploited for better or worse and is deemed worthy of protection. The development of publicity rights has interesting implications for the future of the First Amendment. The Right of Publicity has its origins in privacy law but has actually evolved into a property right and is recognized and treated as such.[1] The Right of Publicity is state based in the U.S.; currently 38 states have some common-law precedent, and 22 states have passed some statute for right of publicity.[2] The limits of what can receive publicity protection is currently being pushed to explore far beyond mere basics such as name, likeness, and photographs. Now things like costumes of movie stars, fictional character roles, individual pieces of clothing from famous sports athletes, the human voice, catch phrases, paraphernalia, peculiar mannerisms, facial

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[1] For more on the origins and evolution of publicity and privacy rights *see* Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 193-199 (1890) (Warren and Brandeis were arguing for creation of common law privacy rights and even described them in terms of property rights thus setting the stage for the later creation of modern publicity rights: "[C]ommon law secures to each individual the right of determining, ordinarily, to what extent his thoughts, sentiments, and emotions shall be communicated to others . . . by word or by signs, in painting, by sculpture, or in music . . . the individual is entitled to decide whether that which is his shall be given to the public.") *Id.* at 198-99; *see also* William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 383-89 (1960) (later on Dean Prosser discusses the Warren and Brandeis article and goes on to lay out 4 distinct kinds of privacy rights 1) intrusion on one's seclusion or solitude, 2) disclosing publicly embarrassing private facts, 3) publicity placing one in a false light, and 4) appropriation of name or likeness); *see also* Dawn H. Dawson, *The Final Frontier: The Right of Publicity in Fictional Characters*, U. ILL. L. REV. 635, 637-39 & n.11-12 (2001) (discussing how this fourth type of privacy would actually evolve and distinguish itself from privacy to become a property right in publicity).

[2] For an interactive map *see*, *Statutes*, RIGHT OF PUBLICITY, http://rightofpublicity.com/statutes (last visited Mar. 28, 2018).

characteristics, and digital avatars, to name but a few examples, are all potentially up for legal protection as they can be found to conjure up the identities of individuals. All of this, and much more, is on track for legal publicity protection. On the other end of the spectrum are those such as advertisers and artists finding ways around restrictions and further testing the limits of what is granted protection under the First Amendment, whether it is through morphing or distorting digital images, using collage and panoramic techniques, disguising advertisements, blending art and commercialism, blending film and advertisements, or using robot look-alikes in advertisements, to name a few. Some argue for and others against the inevitable expansion of publicity rights and whether this may come at a cost to First Amendment freedoms.[3] The predominant problems here, can be attributed to an underlying friction between certain freedoms guaranteed by the First Amendment, and the more recently developing property right protections through publicity rights.

Friction emerges here along divergent lines of exploitation of human identity whether it is for commercial or expressive purposes for example, and the value of such exploitation can be implicated in some cases for good or ill; for the benefit of one or the detriment of another. This friction becomes evident from the variety of tests with vague standards, inconsistent case results, and confusion amongst circuit court rulings that have emerged to try to balance the interests and values encompassing the First Amendment and the Right of Publicity. Overall, the attempts to balance the competing interests and values have led to an atmosphere of legal uncertainty and inconsistent results. This legal uncertainty, on its own, will likely lead to stifling of free speech, expression, and artistic, social, and intellectual endeavors. The question then becomes, how to find the right balance and approach towards protecting against wrongful exploitation of publicity rights without stripping away free speech and stifling creativity. Neither free speech rights nor publicity rights are absolute, but there are some unresolved gray areas and subtle tensions when they clash.

I. BACKGROUND AND CURRENT PRACTICE

This section gives an overview of how the First Amendment and publicity rights come into conflict and what creates this tension. This includes considering some of the specific philosophical underpinnings and arguments that have been advanced as justification for the creation of and enforcement of publicity rights which implicates some of the more overarching justifications for the government placing limitations on freedom of speech and expression to this end. Looking at the state of current practice will entail considering legal developments that have resulted in various tests that have tried to reconcile and balance the inherently competing interests at stake here. Finally, this section will conclude by looking at defenses and exceptions to publicity rights and types of speech that receive protection. This article does not intend to explicitly advocate a rollback of publicity rights or an expansion, but rather invites a discussion and look into why publicity rights are necessary, consider arguments for and against pushing the rights in different directions,

[3] *See e.g.* Linda J. Stack, *White v. Samsung Electronics America, Inc.'s Expansion of the Right of Publicity: Enriching Celebrities at the Expense of Free Speech*, 89 NW. U. L. REV. 1189, (1995); *see also* Jon Siderits, *Celebrities' Expansive "Right of Publicity" Infringes upon Advertisers' First Amendment Rights*, 1 U. CIN. INTELL. PROP. & COMPUTER L.J. (2016), available at http://scholarship.law.uc.edu/ipclj/vol1/iss1/4; *see also* Martin H. Redish & Kelsey B. Shust, *The Right of Publicity and the First Amendment in the Modern Age of Commercial Speech*, 56 WM. & MARY L. REV. 1443, 1447 (2015) (argues that "Today, courts routinely prioritize the pecuniary interest in publicity rights over the First Amendment right of free expression.").

and ultimately move the discussion towards finding that ideal balancing test which has not yet been crafted to deal with the issues and friction that inevitably arise.

A. The Unique Case for Having and Protecting Freedom of Speech, and Freedom of Expression but Also Carving Out Publicity Rights – Having Our Cake and Eating It Too

On the one hand are the important societal interests in having and protecting free speech and expression as guaranteed under the First Amendment: "Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the government for a redress of grievances."[4] On the other hand are rights which have developed and vested in the commercial value of ones persona or identity. The Right of Publicity prescribes liability to one who "appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade…"[5] This Right of Publicity has developed in large part to prevent the unlawful commercial misappropriation and infringement of one's identity, particularly by advertisers who desire to use the identity of famous athletes, celebrities, musicians, etc. to market their goods.[6] Most cases of appropriation of identity involve the commercial use of one's name or likeness.[7] However, indicia of identity can include any number of things besides name or likeness, for instance, voice, signature, nickname, certain traits or characteristics, mannerisms, and paraphernalia peculiar to a specific individuals. Publicity rights do not simply end at a laundry list of enumerated categories, lest the next clever advertiser comes along and thinks of some new way to get around that list.[8] The trend, over time and under current practice, is for publicity rights to protect means of evoking identity or persona that are less and less obvious. Theoretically, anyone can invoke the Right of Publicity, whether a person is a highly regarded and widely known celebrity or the most privately reserved individual; any debate to the contrary is purely academic[9] and not likely to see the light of day. However, in reality it is most often celebrities who are the ones on the front lines bringing publicity claims. Claims can be brought for infringement or misappropriation seeking remedies which include injunction, damages, and punitive damages. In current practice, publicity rights survive death and are generally descendible or assignable but the exact limitations on this will depend on the jurisdiction. Historically, until the 1980's only the four states of Florida, Oklahoma, Utah, and

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[4] U.S. CONST. amend. I.

[5] RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995); For various definitions of publicity rights *see* Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 130 n.13-14 (1993) ("The right of publicity essentially gives a celebrity a legal entitlement to the commercial value of her identity, thus enabling her to control the extent, manner, and timing of its commercial exploitation").

[6] McCarthy, J.T. & PM. Anderson, *Protection of the Athlete's Identity: The Right of Publicity, Endorsements and Domain Names', Marquette Sports Law Review*, 11 MARQ. SPORTS L. REV. 195 (2001).

[7] *See* Sheldon W. Halpern, *The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality*, 46 HASTINGS L. J. 853, 859 (1995).

[8] White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1398 (9th Cir. 1988)("It is not important how the defendant has appropriated the plaintiff's identity, but whether the defendant has done so . . . a rule which says that the right of publicity can be infringed only through the use of nine different methods of appropriating identity merely challenges the clever advertising strategist to come up with the tenth.").

[9] *See* Halpern, *supra* note 7 at 854.

Virginia had a statutory right of survivability.[10] But today, there is a wide range of how long publicity rights survive, with some states granting it only for 10, 20, or 30 years past death, whereas others go all the way up to 100 years or indefinitely.[11]

1. Having and Protecting Free Speech Under the First Amendment

The First Amendment and free speech serve many important functions and values which are wrapped up in the human needs for identity, fulfillment, and self-expression.[12] The prominent First Amendment scholar Professor Emerson recognizes the importance of First Amendment freedom for 4 primary values: 1) individual self-fulfillment, 2) advancing knowledge and truth, 3) participation in decision for all members of society, and 4) creating a more adaptable and stable community.[13] This discussion necessitates a consideration of what types of speech the First Amendment actually protects and how much protection is guaranteed. It is useful to frame the First Amendment in a negative calculus.[14] Firstly, freedom of speech and expression is not absolute under the First Amendment.[15] Freedom of speech "does not confer an absolute right without responsibility", or an "unbridled license" giving "immunity for every possible use of language" and "prevent[ing] the punishment of those who abuse this freedom."[16] Certain categories of speech are simply not protected in general under the First Amendment including obscenity, child porn, and fighting words.[17] Secondly, all other speech is potentially subject to regulation, restriction, and limitations that can be imposed by the U.S. government in a variety of ways, for example, content based restrictions and prior restraints.[18] Furthermore, the Supreme Court has not entirely foreclosed the possibility of recognizing additional categories of unprotected speech.[19]

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[10] Edward H. Rosenthal, *The Right of Publicity* 1, 7 (Aug. 2014), http://www.americanbar.org/content/dam/aba/administrative/litigation/materials/2015_intellectual_property_lit/materials/the_right_of_publicity_article_rosenthal.authcheckdam.pdf.

[11] *Id*. at 7-9.

[12] Justice Brandeis says the goals of the First Amendment include 1) enlightenment, 2) self-fulfillment, and 3) the safety valve *see*, Whitney v. California 274 U.S. 357, 375 (1927).

[13] C. Edwin Baker, *Scope of the First Amendment Freedom of Speech*, 25 UCLA L. REV. 946-1040 (1978) citing prominent first amendment scholar Professor Emerson; *see also* Thomas I. Emerson, *Toward A General Theory of the First Amendment*, 72 YALE L.J. 877-87 (1963); *but see* FREDERICK SCHAUER, FREE SPEECH: A PHILOSOPHICAL ENQUIRY, 19-29 (Cambridge Univ. Press 1982) (discussing how truth is defined, the survival theory of truth in the marketplace of ideas, open discussion, and rational thinking as the goal rather than just knowledge).

[14] *See* Ronald A. Cass, *The Perils of Positive Thinking: Constitutional Interpretation and Negative First Amendment Theory*, 34 UCLA L. REV. 1405, 1411-51 (1987) for a negative theory of the First Amendment and categories of speech closer or further from its core concerns.

[15] *Id*.

[16] *See* Gitlow v. NY, 268 U.S. 666-667 (1925).

[17] *See generally*, Kathleen Ann Ruane, *Freedom of Speech and Press: Exceptions to the First Amendment*, CRS Report 95-815, (Sep. 2014), 1-35.

[18] *Id*.

[19] U.S. v. Stevens, 559 U.S. 460 (2010).

2. First Amendment Protection of Expressive versus Commercial Speech

One of the core issues debated in this arena of rights[20] is how to define expressive versus commercial speech because it is not always clear cut and these different types of speech receive different levels of protection under First Amendment precedent. The Supreme Court recognizes a difference between commercial speech and expressive speech.[21] "The First Amendment fully protects expressive speech, including political speech, news and matters of public interest, parodies, fictional works, artistic expressions, and cultural expression and recoding."[22] The First Amendment grants less protection to commercial speech than expressive speech.[23] But there is no constitutional protection for false or misleading speech.[24] The Supreme Court decision in *Central Hudson Gas & Electric Corp. v. New York* provides the modern standard by which the government can regulate speech found in commercial advertising contexts. The Court provides a four prong analysis: 1) whether the speech at issue is lawful and not misleading, 2) whether the asserted governmental interest is substantial, 3) whether the regulation directly advances the governmental interest asserted, and 4) not more extensive than necessary to serve the governmental interest.[25] Commercial speech at its core is actually quite limited; it is "speech that does 'no more than propose a commercial transaction.'"[26] Even pure commercial speech at its core, receives some protection – the free flow of information serves to enlighten public decision making.[27]

In examining "profit" and "for trade purposes" it is important to consider that just because "books, newspapers, and magazines are published and sold for profit does not prevent them from being a form of expression whose liberty is safeguarded by the First Amendment."[28] An area of commonality in the jurisprudence has developed through a line of cases supporting the idea that speech for profit does not lose constitutional protection.[29] Profit is separable from commercial exploitation and it is important to keep this distinction in mind. On the other hand, there is no requirement that one must undertake an action for profit in order to invade the right of publicity.[30] Rather, a person could invade another's publicity rights intentionally or even unintentionally without making any money at all and it is still an invasion.

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[20] *See* Baker, *supra* note 13 at 946-1040 (Baker proposes a "liberty model" in which free speech does not protect a marketplace but instead protects "an arena of individual liberty from certain types of governmental restrictions.").
[21] Cent. Hudson Gas & Elec. Corp v. Pub. Serv. Comm'n of New York, 447 U.S 557 (1980).
[22] Gloria Franke, *The Right of Publicity vs. the First Amendment: Will One Test Ever Capture The Starring Role?*, 79 S. CAL. L. REV. 945, 960 (2006).
[23] *See Cent. Hudson*, 447 U.S. 557 at 563.
[24] *See* Gertz v. Robert Welch, Inc., 418 U.S. 323, 340 (1974); Zauderer v. Office of Disciplinary Counsel, 471 U.S. 626, 638 (1985).
[25] *See Cent. Hudson*, 447 U.S. 557 at 564 (the government bears the burden of identifying and proving the substantial interest).
[26] Va. State Bd. Of Pharmacy v. Va. Citizens Consumer Council, 425 U.S. 748, 771-72 n.24 (1976) (quoting Pittsburgh Press Co. v. Human Relations Comm'n, 413 U.S. 376, 385 (1973)); *but see* Stephanie Marcantonio, *What is Commercial Speech? An Analysis in Light of Kasky v. Nike*, 24 PACE L. REV. 357 (2003) (discussing some of the difficulties and intricacies in defining Commercial Speech).
[27] *See generally*, *Va. State Bd. Of Pharmacy v. Va. Citizens Consumer Council*, 425 U.S. 748.
[28] Time, Inc. v. Hill 385 U.S. 374, 397 (1967) (citing Burstyn, Inc. v. Wilson, 343 U.S. 495, 501-502).
[29] *Id.*; New Kids on the Block v. News America Pub., Inc., 745 F. Supp. 1540 (C.D. Cal. 1990); New York Times Co. v. Sullivan, 376 U.S. 254 (1964); Joseph Burstyn, Inc. v. Wilson, 343 U.S. 495 (1952).
[30] *See generally*, Franke, *supra* note 22.

3. Carving Out Publicity Rights from the First Amendment

Going back to the 1950's, *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.* is often claimed to be the case that established the modern Right of Publicity and for which the phrase "Right of Publicity" has been coined.[31] Baseball players gave consent to competing chewing gum manufacturers to use their photographs in conjunction with the sale of gum.[32] The court found that "in addition to and independent of that right of privacy . . . a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture . . . ."[33] Judge Frank wrote:

> many prominent persons (especially actors and ball-players), far from having their feeling bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways.[34]

This illustrates the basic justification for publicity rights which is distinct from privacy. People have an interest in controlling and benefiting from their identity, likeness, or image (or any other form of publicity-related property), hence a right to control how their likeness is displayed and held out to the public, and an interest in receiving adequate compensation (weight is given to economic incentives) for commercial exploitation of their property.

Zacchini v. Scripps-Howard Broadcasting Co. is the only Supreme Court case addressing publicity rights.[35] *Zacchini* involved a television station making an unauthorized broadcast of the plaintiff's 15 second "human cannonball" act.[36] Hugo Zacchini spent much of his life pioneering and perfecting his cannon-ball act. He did this for a living. In August of 1972, when he came to Geauga County Fair in Burton, Ohio to perform, a free-lance reporter asked if he could record Hugo; to which Hugo asked him to not record, as his performance was his livelihood.[37] The reporter came back the next day and hid in the crowd, made a 15 second recording, and it aired on the 11 o'clock news.[38] The Court held that the "broadcast of a film of petitioner's "entire act" poses a substantial threat to the economic value of that performance" and was a violation of the plaintiff's publicity rights.[39] However, it has been pointed out that the Supreme Court may have actually sidestepped the crux of the issue to some degree by producing this "entire act" standard.[40] A performer's entire act is possible the most clear cut example of a misappropriation. What more is their left to misappropriate beyond a performers entire performance. What this framework actually answers is very little if anything, and today there are much less obvious misappropriations occurring than an entire performance. Furthermore, there are holes even in this approach because

[31] Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866 (2d Cir. 1953).
[32] *Id*. at 866-68.
[33] *Id*. at 868.
[34] *Id*.
[35] Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1997).
[36] *Id*. at 563.
[37] *Id*. at 563-64.
[38] *Id*.
[39] *Id*. at 575.
[40] *See* Halpern, *supra* note 7 at 867 ("[T]he Supreme Court has not dealt directly with a paradigmatic right of publicity case.").

what about the time before and after the 15 seconds, including the fanfare and setting up for the cannon blast, could this be part of the "entire performance"? Instead, courts have virtually ignored this "entire act" approach and come up with different approaches.[41] *Zacchini* demands a balancing test[42] but provides very little guidance which is evident from the panoply of tests emerging across various courts. What we are left with is 50 state versions of the law and a few prominently emerging Circuit court tests and lots of inconsistency.

> In balancing publicity and First Amendment rights, it is also necessary to consider that First Amendment guarantees of free speech serve two important purposes: first, they advance knowledge and the search for truth by fostering a free marketplace of ideas and an "uninhibited, robust, wide-open debate on public issues," and second, they fulfill the human need for self-expression and self-realization.[43]

In one sense, publicity rights can certainly take away and carve up tiny little slivers or pieces of the First Amendment to be handed out as property for ownership. This is good in some ways and not so good in other ways. What is not so good is that the effect of awarding ownership rights to certain people would deprive others of access to those communicative resources, in some instances even silencing speech in ways that could be deemed invasive or exploitative, or not permissible. But publicity rights do not just take away from the First Amendment, they also give back and help uphold the First Amendment in certain ways. The right to control one's image that is put out to the public has grounding and importance in helping achieve and protect certain First Amendment values. The right to control one's public image is tied to the ability to define oneself, defining one's identity through voluntary self-expression, achieving self-fulfillment through meaningful participation (Edwin Baker gives an example of meaningful participation as protesting the Vietnam War regardless of actually having an impact or changing anything), and self-realization.[44] Also implicated by this is one's ability to control one's identity and associations and to communicate ideas to others about oneself. To misappropriate or trespass on someone's right in this regard is going to impede First Amendment values (image advertisers could just take anyone's image and slap it on a product). On the flip side, where speech is being silenced or pre-empted as in the case of stylistic confinement,[45] this will equally impede the First Amendment, but merely on the opposite side of the equation.

B. Competing Interests and Rights at Stake When the First Amendment and Publicity Rights Clash: Three Primary Brands of Argument Being Advanced to Justify Publicity Rights

Key to the First Amendment and publicity rights equation is seeing the two opposing sides that crop up in the cases and the rationales underlying both. Typically, there will be the rights holders, whether a living celebrity, or their heirs and estates and assignees. Their incentive is to

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[41] *See infra* Part II C for three of the emerging Circuit Court tests.
[42] Thomas E. Kadri, *Fumbling the First Amendment: The Right of Publicity Goes 2—0 Against Freedom of Expression*, 112 MICH. L. REV. 1519, 1522 (2014).
[43] Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 65-66 (1994).
[44] *See generally*, C. Edwin Baker, *Scope of the First Amendment Freedom of Speech*, 25 UCLA L. REV. 1009-1040 (1978).
[45] *See infra* Part III D on stylistic confinement.

protect their property interest and maximize control or influence over the exploitation thereof to their benefit or purpose. On the other side of the equation could be some other party or parties such as companies, or artists, or the news media who seek to exercise their freedoms to exploit some subject matter that is in question. Also, it's important not to overlook the impact on the public in general, even though typically not a party in the suit here. There are many good reasons, theories, and philosophies underlying and supporting the Right of Publicity. There are three primary lines of argument that are used in support of publicity rights which include economic, moral, and consumer protection.[46] Many tend to favor certain arguments here such as the economic ones while giving short shrift to certain ones especially moral arguments, but it is important to not so quickly write any of them off.

Moral arguments include rewarding labor and enjoying the fruits of one's labor which is rewarding the hard work, effort, time, resources, and skill one puts into something; conversely, this includes preventing unjust enrichment whereby someone is unfairly reaping the benefits of another intentionally or even unintentionally.[47]

Moral arguments can also encompass the ability to control one's image and one's personhood, individual autonomy, personal dignity, preventing misrepresentation of values, and preventing harm from association.[48] Infringement or misappropriation can deprive one of the choice of how to use or associate their image. People may be led to wrongly believe that one is associated with some product or cause. Reputational damage could also be done through false or misleading information. Some have pointed out emotional harms that can accompany misappropriation of identity – misappropriation of identity can induce embarrassment, humiliation, and mental distress.[49] For example, in *Grant v. Esquire Inc.*, the plaintiff was able to recover for "lacerations to his feelings" after a magazine publisher superimposed Cary Grant's head on a clothing model's torso.[50]

There are many economic reasons for supporting publicity rights including providing incentives for socially useful activities and the creation of works and property, which benefit society as a whole. There are both individual and societal benefits implicated by publicity rights. Economic arguments also include economic efficiency in the face of resource scarcity, "avoiding rent dissipation", and avoiding waste.[51]

Finally, there are also consumer protection arguments which include guarding against consumer confusion, preventing victimization of both the individual and the public from false claims about products, and the public being misled about a "celebrity's willingness to associate himself with a product or service."[52] Consumer protection arguments are often considered weak and there are other legal remedies and avenues already provided against such "deceptive trade practices and unfair competition."[53]

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[46] *See generally*, Redish & Shust, *supra* note 3 and Franke, *supra* note 22.
[47] *See* Redish & Shust, *supra* note 3.
[48] *Id. at* 1451-62.
[49] *See* Dawson, *supra* note 1 at 646.
[50] Grant v. Esquire, Inc., 367 F. Supp. 876 (S.D.N.Y. 1973).
[51] *See generally*, Redish & Shust, *supra* note 3 at 1462-65.
[52] *Id. at* 1466.
[53] *Id.*

Overall, there is a combination of sound reasoning, strong grounds, and many proponents for having and enforcing publicity rights. However, there are criticisms, counterarguments and even potential holes in some of these theories; theories which favor the development of publicity rights. There is not enough room here to explore them all save one or two. Fame is not in truth, contingent on one's hard work, effort, skill, or time, and one cannot make oneself famous, but is instead a "relational phenomenon" conferred by others.[54]

> The constitutional right of free expression is powerful medicine in a society as diverse and populous as ours. It is designed and intended to remove governmental restraints from the arena of public discussion, putting the decision as to what views shall be voiced largely into the hands of each of us, in the hope that use of such freedom will ultimately produce a more capable citizenry and more perfect polity and in the belief that no other approach would comport with the premise of individual dignity and choice upon which our political system rest.[55]

The primary theories and justifications for publicity theories fail to account for the audience. Without the audience, there would be no publicity to begin with. Furthermore, is there truly no value in their reception of the information, whether it is for humor or decision making? A whole host of potential holes is exposed by consumer protection arguments particularly because other avenues may already be available as solutions including likelihood of confusion, false light, false endorsement, and no constitutional protection for false or misleading speech.

C. No Clear Winner in Sight – Inconsistent Tests Emerging to Bring Balance to the Chaos

Many are identifying problems with the current practice for publicity rights. For instance, one major problem is the failure of states to develop tests that are consistent and effective to safeguard freedom of speech.[56] Some are even proposing the creation of a federal statute for the right of publicity as a solution to address problems in current practice.[57] As a result of the vague demands for a balancing test from the Supreme Court in *Zacchini*, there is much lower court confusion and chaotic application, with circuit courts coming out different ways and promulgating different tests and approaches. Many of these have been rejected but a few have come to prominence including 1) the Transformative Use Test, 2) the Rogers Test, 3) the Predominant Use

[54] Mark S. Kontopoulos, The Right of Publicity, Morality and Free Speech: An 'Uneasy' Relationship (April 2002) (dissertation, KENT LAW SCHOOL INTELLECTUAL PROPERTY LW 556) at 11, available at https://view.officeapps.live.com/op/view.aspx?src=https%3A%2F%2Fwww.kent.ac.uk%2Flaw%2Fip%2Fresources%2Fip_dissertations%2F2001-02%2FDiss-Kontopolous.doc.

[55] *See* Cohen v. Cal., 403 U.S. 15 (1972).

[56] Susannah M. Rooney, *Just Another Brown Eyed Girl: Toward A Limited Federal Right of Publicity Under the Lanham Act in a Digital Age of Celebrity Dominance*, 86 S. CAL. L. REV 924 (2013); *see also* Franke, *supra* note 22.

[57] *Id*. at 921-958 (proposing a federal right of publicity under the Lanham Act).

Test.[58] Furthermore, these tests are being criticized for vague standards and inconsistent application.

1. Transformative Use Test

The governing test for California, which is being adopted increasingly outside California,[59] was promulgated in *Comedy III Productions v. Gary Saderup, Inc.*[60] Under *Comedy III*, First Amendment protection is limited to works that are transformative and the court conducts a test relying on at least five factors.[61] The *Transformative Use Test* includes the following five factors and is perhaps the closest to an ideal test so far but not yet perfect enough to be accepted everywhere universally:

> 1) the celebrity likeness is one of the raw materials from which an original work synthesized; 2) the work is primarily the defendant's own expression if the expression is something other than the likeness of the celebrity; 3) the literal and imitative or creative elements predominate in the work; 4) the marketability and economic value of the challenged work derives primarily from the fame of the celebrity depicted; and 5) an artist's skill and talent has been manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit the celebrity's fame.[62]

The Transformative Use Test most importantly asks whether one has put their own creativity into the work and looks at the sum of the parts. This test could be likened to a fine brush stroke approach that is very much dependent on the technique of the artist or the expressive content; it looks at what sets the new work apart from the original likeness, including considering what parts are literally borrowed or imitated versus which parts are something truly of the defendant's own creative expression. This is somewhat like a test of originality and the test appears to treat the said likeness in question as if it were some piece of artwork. And yet this test has received a lot of scholarly criticism and many have dubbed it as "unworkable" due to problems with application and interpretation even within its inception to the case *Comedy III* from which it came – the test seems to borrow from copyright law and the definition of fair use.[63] The test provides a good

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[58] Ronald S. Katz, *When Rights of Publicity Trump First Amendment*, LAW360, (May 22, 2013, 1:06 PM) https://www.law360.com/articles/444030/when-rights-of-publicity-trump-1st-amendment (more than half a dozen tests have been used to balance the First Amendment and publicity rights).

[59] Michael Davis-Wilson, *Publicity rights vs. the First Amendment*, FENWICK.COM, (Feb. 19, 2014), https://www.fenwick.com/publications/pages/publicity-rights-vs-the-first-amendment.aspx.

[60] Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797 (Cal. 2001).

[61] *See* Franke, *supra* note 22 at 971 (contending the lack of one clear definition and the vague standard created by the transformative use test chills free speech).

[62] *Comedy III v. Saderup*, 21 P.3d 797 at 808.

[63] *See* Franke, *supra* note 22 at 970-74. (discussing the Transformative Use Test and drawing on many of its scholarly criticisms, how it lacks a clear definition, has proven extremely vague in application through inconsistent court holdings, how it encourages judges to be art critics and other flaws underlying the logic of protecting transformative works but not protecting non-transformative works). For further criticism of the test *see also*, Doe v. TCI Cablevision, 110 S.W.3d 363 (Mo. 2003) (in which the Supreme Court of Missouri argues the Transformative Use Test overextends First Amendment Protection).

foundation and starting point for sorting out whether and how a celebrity likeness is indeed being exploited through factors one, two, and three, and for considering to what end the likeness is being exploited through factors four and five. But, this test leaves much unanswered concerning what speech ultimately should and should not be protected under the First Amendment.

2. Rogers Test

The Sixth Circuit is the only circuit to adopt the Rogers Test (also called the Relatedness Test or the Restatement Test) for the publicity arena and it has been used inconsistently therein.[64] The test derives from the case *Rogers v. Grimaldi* in which the famous actress Ginger Rogers sued the film producers and distributors of "Ginger and Fred" which was a film about the dancing career of two fictional Italian cabaret performers who imitated Ginger Rogers and Fred Astaire her frequent onstage partner.[65] The Rogers Test aims to prevent consumer confusion: step 1) is determining whether use of name or likeness is at least minimally relevant to the underlying work – if the answer is no then no First Amendment protection, if yes then move on to step 2) which is determining whether the work is simply a disguised advertisement – if yes then there is no First Amendment protection.[66] In *Rogers v. Grimaldi*, the Sixth Circuit found the film was protected.[67] The key language for the first part of this test is "minimally relevant." Like the previous Transformative Use Test, this language is useful in discerning the purpose of a celebrity invocation. This test brings something different to the table in that it appears to focus more on the aspect of "use" and to what "degree." This test raises the importance of relevance and degree of the use. Step two really hits hard against a nature of use being that of disguised advertising. Moreover, the test considers how the likeness is being used.

The Third Circuit has rejected and criticized the Rogers Test as subjective and arbitrary contending it calls on judges to act as impartial jurists and discerning art critics.[68] But this test leaves unanswered much, even regarding use, including what uses are permissible and protected versus which ones are not except for the explicitly stated category of disguised advertisements.

3. Predominant Use Test

The Predominant Use Test originated from a law review article by Mark Lee and has been adopted in particular by the Third Circuit.[69] The Third Circuit gave a recent illustration of the test in *Hart v. Electronic Arts Inc*.:

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[64] Parks v. LaFace Records, 329 F.3d 437 (6th Cir. 2003) which adopted the Rogers Test for a publicity dispute; *but see* ETW Corp. v. Jireh Pub.'g. Inc., 332 F.3d 915 (6th Cir. 2003) which acknowledges Parks but does not apply the Rogers Test to the publicity claim at issue).
[65] Rogers v. Grimaldi, 875 F.2d 994 (2nd Cir. 1989).
[66] *Id. at* 996-97.
[67] *Id. at* 1005.
[68] *See* Hart v. Elec. Arts, Inc., 717 F.3d 141 (3rd Cir. 2013) (the third circuit rejected the Rogers and Predominant Use Tests in favor of the Transformative Use Test for this case).
[69] Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471 (2003); *see also* Redish & Shust, *supra* note 3 at 1476.

> If a product is being sold that predominantly exploits the commercial value of an individual's identity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some 'expressive' content in it that might qualify as 'speech' in other circumstances. If, on the other hand, the predominant purpose of the product is to make an expressive comment on or about a celebrity, the expressive values could be given greater weight.[70]

The test essentially looks to what the primary purpose of the use is; whether this is to merely exploit the likeness of another, or whether the purpose was expressive instead; requiring a weighing of the purpose to determine whether commercial exploitation or expression predominates. This test recognizes the potential for expressive content in a product and the possibility for multiplicity in speech purpose here, particularly the possibility of speech being a mixture of simultaneous commercial exploitation and expression. But this test is tackling the issue from a much more broad-brush stroke than the other approaches, if the intention is to make an expressive comment, then it may get protection. It all hinges on how to interpret "expressive comment" and whether the speech falls inside the interpretation of "expressive comment" or not. This leads right back to what constitutes expression and what constitutes mere commercial and exploitative speech. This also begs the more important and illusive question (at least from a negative First Amendment calculus perspective) of what qualifies as not an expressive comment. What about purely factual information? Certainly, determining the true purpose of the speech here and whether it is predominantly exploitative in a bad way (especially commercially) is important in the sum total of this inquiry but this approach leaves many questions unanswered and unsatisfactory.

D. Lines of Defense and Exceptions to Publicity Rights – Speech Deemed Worthy of Protection and the Need for Freedom

Celebrity control and publicity rights cannot be absolute[71] and there are several lines of defenses that have been created. Not all the defenses will be mentioned here but it is important to highlight briefly a few of them. Lines of defense have and must be brought including, matters that are newsworthy or of legitimate public concern, parody, and many states are developing varying public interest exceptions, there is also much First Amendment protection being garnered for literary and artistic works.

1. Newsworthy and Legitimate Public Interest

Despite the different paths courts are taking with the various emerging tests to handle issues of publicity rights, there are some areas of commonality being developed in the law and in particular along the lines of defenses. Courts are increasingly embracing exceptions for matters that are 1) newsworthy or 2) matters of legitimate public concern.[72] There is great importance for

[70] *See Hart* v. *Elec*. *Arts*, 717 F.3d 141 at 154.
[71] Hicks v. Casablanca Records, 464 F. Supp. 426 (S.D.N.Y. 1978).
[72] Allen Rostron, *The Mugshot Industry: Freedom of Speech, Rights of Publicity, and the Controversy Sparked by an Unusual New Type of* Business, 90 WASH. U.L. REV. 1329-30 (2013).

establishing and developing lines of defense along these avenues because it affects the very flow of information in a democracy and informed public decision making. Inadequate access to information, would likely disserve the public as a general matter.

The precious little freedom that is granted under these avenues is counterbalanced in some ways for instance there is a privacy tort that has developed called "false light" that is closely related to defamation that can be brought where 1) published information casts a person in a false light, 2) is highly offensive to a reasonable person, and 3) is published with knowledge or reckless disregard of the falsity.[73] This covers embellishment, distortion, stock footage in a news story, the addition of false material, disguised fictional references to real people.[74] However, some courts consider works of fiction constitutionally protected even if they resemble clearly identifiable people.[75] Generally, information that is deceptive, false, or misleading is not going to be constitutionally protected under the First Amendment.[76]

2. Parody

Parody has been established as a major defense in the realm of intellectual, against publicity rights, and against libel and defamation.[77] *Cardtoons, L.C. v. Major League Baseball Players' Ass'n*, is the case that established parody as a major defense against publicity rights.[78] *Cardtoons* dealt with trading cards featuring humorous major league baseball player caricatures ridiculing the players in many ways including their physical characteristics, egos, and compensation.[79] The court in *Cardtoons* exemplifies the societal and First Amendment importance of Parody:

> A parodist can, with deft and wit, readily expose the foolish and absurd in society. Parody is also a valuable form of self-expression that allows artists to shed light on earlier works and, at the same time, create new ones. Thus, parody, both as social criticism and a means of self-expression, is a vital commodity in the marketplace of ideas.[80]

Parody is worthy of First Amendment Protection and is an area that should not be carved up by Publicity Rights but rather the freedoms associated with parody should be strongly preserved because parody is so valuable. Parody is a powerful and healthy outlet and public vehicle for

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[73] For a brief description of false light compared to other types of misappropriation *see* Reporters Committee for Freedom for Freedom of the Press, *False Light – Misappropriation – Right of Publicity*, RCFP.ORG, http://rcfp.org/first-amendment-handbook/false-light-misappropriation-right-publicity (last visited Mar. 25, 2018).
[74] *Id.*
[75] Polydoros v. Twentieth Century Fox Film Corp., 965 P.2d 724 (Cal. 1998), aff'g 79 Cal. Rptr. 2d 207 (Cal. Ct. App. 1997).
[76] *See supra* note 24.
[77] *See* Hustler Magazine v. Falwell 485 U.S. 46, 56 (1988) ("Under the free speech guaranties of the Federal Constitution's First Amendment, public figures and public officials may not recover for the tort of intentional infliction of emotional distress by reason of publications caricaturing them unless they show . . . a false statement of fact which was made with actual malice.").
[78] Cardtoons, L.C. v. Major League Baseball Players' Ass'n 95 F.3d 959 (10th Cir. 1996).
[79] *Id.;* Ku, Raymond Shih Ray, *Is Nominal Use An Answer to the Free Speech & Right of Publicity Quandary?: Lessons from America's National Pastime*, 11 CHAPMAN L. REV. 435 (2008): 440-42, available at http://scholarlycommons.law.case.edu/faculty_publications/131.
[80] *Cardtoons*, 95 F.3d 959 at 972.

expression, criticism, and new ideas. Some counter arguments against parody can include whether there is any serious reputational or emotional damage done to whoever is being parodied, and how is too far to extend parody protection, certainly there must be limits to what is parody.

II. DISCUSSION

A. Inconsistent Results Commercially Exploiting Name or Likeness: A Tale of Kings and Parks

The Georgia Supreme Court in *Martin Luther King, Jr. Center for Social Change v. American Heritage Products* recognized a "celebrities right to the exclusive use of his or her name and likeness" holding that the First Amendment did not protect the right to manufacture and sell plastic busts of public figure and civil rights hero Dr. Martin Luther King Jr.[81] Contrast this with a more recent case in 2016, *Rosa & Raymond Parks Inst. For Self Dev. V. Target Corp* in which the Eleventh Circuit held Michigan publicity rights cannot prevent a store from selling movies, books, and plaques in honor of Rosa Parks because such activities are protected by First Amendment free speech guarantees.[82] What is in common with both of these cases is that they both involve historical public figures (civil rights icons even) who were not public officials but rather private individuals, whose publicity rights survived them and passed along to their estates. However, both cases came out quite differently.

The Supreme Court of Georgia in *Martin Luther King v. American Heritage* held that publicity rights do in fact survive death (this follows the trend mentioned earlier), also that they need not be commercially exploited by a person in order to be protected.[83] However, the court left unclear and un-fully answered how to define commercial exploitation and the analytical framework for determining whether there is commercial exploitation.[84] What happened was the defendant hired an artist and sold around 200 busts of Dr. King; the defendant used his company B & S Sales to manufacture which would merge with his newly created B & S Enterprises which was created to sell the busts, all allegedly in Dr. King's honor.[85] The Defendant took out two magazine advertisements, held his work out as an "exclusive memorial" and "an opportunity to support the Martin Luther King, Jr. Center for Social Change", and testified that he set aside 3% of each sale (roughly $30 purchase price) for the Center in a trust fund which would send them the money.[86] The magazine advertisements also offered a free booklet about the life of Dr. King titled "A Tribute to Dr. Martin Luther King, Jr."[87] He also published a brochure or pamphlet which was inserted in 80,000 copies of newspapers around the country which restated the same things covered in the magazine advertisements, and contained photographs of Dr. King and excerpts from his copyrighted speeches.[88] Although Dr. King never commercially exploited his own image himself

[81] Martin Luther King, Jr. Center for Social Change v. American Heritage Products, 296 S.E.2d 697 (Ga. 1982).
[82] Rosa & Raymond Parks Inst. For Self Dev. V. Target Corp, 812 F.3d 824 (11th Cir. 2016).
[83] *See Martin Luther King v. American Heritage*, 296 S.E.2d 697 at 705-06.
[84] *Id. at* 697-706.
[85] *Id. at* 698-99.
[86] *Id.*
[87] *Id.*
[88] *Id.*

during his lifetime, his image has often been commercially exploited by others, he was a Baptist minister by profession, and perhaps doing so would have impeded his ministry.[89]

Ultimately, the court found in favor of the plaintiffs, who collectively owned the publicity rights of Dr. King, but I suspect the court was grappling with how to define commercial exploitation even struggling with the subtle tension here between the emerging publicity rights jurisprudence and First Amendment implications. Justice Weltner's partial concurrence and partial dissent is illustrative of a few interest points of this struggle:

> [M]ajority says that the fabrication and commercial distribution of a likeness of Dr. King is not "speech," thereby removing the inquiry from the ambit of the first Amendment or Free Speech inquiry . . . When our Constitution declares that anyone may "speak, write and publish his sentiments on all subjects" it does not confine that freedom exclusively to verbal expression. Human intercourse is such that at times the most powerful of expressions involve no words at all . . . . Are not the busts of former chief justices, stationed within the rotunda of this very courthouse, expression of sentiments of gratitude and approval?[90]

Justice Weltner also raises hypothetical and even real-life art examples including a Portrait of Dr. King that was hung in the State Capital, further how this case could be resolved in terms of being unjust enrichment, and yet how financial gain cannot be the ultimate dividing line, instead we must look to community judgment of what ex aesquo et bono, is unconscionable.[91]

In sharp contrast, the Eleventh Circuit in *Rosa & Raymond Parks v Target* would go on to hold that a commemorative plaque and several other products honoring Rosa Parks all can be sold by Target, a national retailer under First Amendment protection.[92] The Eleventh Circuit established what some could call a new public interest test. Concerning the collage style plaque which placed an image of Parks next to an image of Dr. King, the court considered the plaque itself as art and noted how public interest extends not only to sharing historical and educational information, but also entertainment, and amusement even when that interest conflicts with a right of publicity.[93] Furthermore, the court noted the historical significance of Rosa Parks's image for Civil Rights and how sharing history is in the general public's interest.[94]

Another case, *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915 (6th Cir. 2003), invoked Ohio common law publicity rights and was a First Amendment win for an artist upholding his First Amendment rights to sell prints of a painting depicting world famous golfer Tiger Woods in his 1997 Masters Tournament victory.[95] The painting was a collaged styled work depicting Woods in a panorama of different poses and the artist sold around 5000 prints of the work.[96] This was not a

[89] *Id. at* 700.
[90] *Id. at* 708.
[91] *See Martin Luther King v. American Heritage*, 296 S.E.2d 697 at 708-09.
[92] *See Rosa & Raymond Parks v. Target*, 812 F.3d 824 at 827-32.
[93] *Id. at* 830-32.
[94] *Id. at* 831.
[95] ETW Corp. v. Jireh Publishing, Inc., 332 F.3d 915, 918-919 (6th Cir. 2003).
[96] *Id.*

parody at all but more along the lines of a serious portrait and depicting Tiger Woods doing what he performs for a living even, and this was a win for works of art under the First Amendment.

In the case of *Parks v. LaFace Records*, the music group Outkast released an album titled "Aquemini" containing a song titled "Rosa Parks" which garnered Billboard Chart success and helped the group land a Grammy nomination.[97] The chorus of the song contained the phrase "move to the back of the bus" in reference to her brave historical act of refusing to give up her bus seat to a white passenger. Rosa Parks brought suit over the use of her name without her consent however the case would ultimately get settled.[98] The case raises the issue of using someone's name as the title of a musical work and it would have been interesting to see the outcome had the case been pursued.

Martin Luther King v. American Heritage, highlights the struggle going on here, the same issues that the court was struggling with back in the 1980's are still the same issues underlying the more recent cases. The framework and analysis for determining what constitutes "commercial exploitation" versus what constitutes protected free speech has been left ambiguous and not satisfactorily filled in for how courts should arrive at that. Instead, each state or Circuit Court is doing its own thing and while there may be areas of common development, there are also areas of stark contrast.

B. Expressive Speech and Commercial Speech Dichotomy – A Key Factor For Harmonizing the Inherent Tension Between the First Amendment and Publicity Rights

Gloria Franke points out one of the key issues that is creating tension between the First Amendment and Publicity Rights which is giving courts such trouble in trying to find a resolution. What is problematic is that speech can be both commercial and expressive at the same time or contain elements of both simultaneously.[99]

1. Recognizing Speech with Commercial and Non-commercial Elements: Speech with Dual Roles

The court in *Jordan v. Jewel Food Stores, Inc.*, finds and discusses a dual role of speech found in a store advertisement containing a letter honoring the famous basketball player Michael Jordan yet also calculated to the financial gain of the store.[100] When Michael Jordan was inducted into the Naismith Memorial Basketball Hall of Fame in 2009, Time, Inc. the publisher of Sports Illustrated ran a commemorative issue, they offered Jewel Food Stores which operated 175 supermarkets in and around Chicago a free advertising space in the magazine in exchange for stocking the magazine in store.[101] Jewel accepted and published a one page letter in honor of Michael Jordan which showed an image of his shoes with the distinctive number 23 which is

[97] Parks v. LaFace Records, 329 F.3d 347, 441-444 (6th Cir. 2003).
[98] *Id.*; LaFace Records v. Parks, 540 U.S. 1074 (2003) (cert. denied).
[99] *See* Franke, *supra* note 22 at 960-961.
[100] Jordan v. Jewel Food Stores, Inc., 743 F.3d 509 (7th Cir. 2014).
[101] *Id. at* 511.

Michael Jordan's number and also featured prominently the "Jewel-Osco" logo.[102] The court found a dual role here and weighed in favor of plaintiff Michael Jordan; that the commercial elements outweighed the expressive speech.[103] In this case, the problem with the speech was that the commercial purpose was deemed to be for general brand promotion or brand loyalty. This is more abstract than the core of commercial speech which is nothing more than to propose a commercial transaction. In fact, in this case there was absolutely no transaction implied or suggested for buying any products, but since the purpose can be found to be towards general brand promotion then that purpose outweighs the free speech under the court's analysis.[104] The store was deemed to have been free-riding on the Michael Jordan's goodwill and lost.[105] The court found that the Bolger framework applies because this is speech containing commercial and non-commercial elements.[106] The Bolger inquiry asks: 1) whether the speech in question is in the form of an advertisement, 2) refers to a specific product, 3) has an economic motive.[107] The court also goes on to discuss the "inextricably intertwined principle" which applies only when "it is legally or practically impossible for the speaker to separate out the commercial and non-commercial elements of his speech", but as in this case – simply combining elements of commercial and non-commercial is not enough to transform the whole thing into non-commercial speech.[108] These principles all very much relate back to the concept of disguised advertising, and this test is useful solving the commercial expressive dichotomy because it recognizes the mixture and variation of commercial and non-commercial elements and how they can be at times inseparable.

2. Problems Underlying Commercial Speech Rationales

Courts have to draw lines somewhere and this question of where to draw the line is breeding tension. How far can we take this idea of commercial exploitation and stretch its application before it rips; before it becomes a paradigm for celebrity censorship? Michael Madow raises many important points about the expressive, communicative, and symbolic power behind celebrities and our use of them in even our daily speech:

> Entertainment and sports celebrities are the leading players in our Public Drama . . . We copy their mannerisms, their styles, their modes of conversation and consumption. Whether or not celebrities are "the chief agents of moral change in the United States," they certainly are widely used . . . to symbolize individual aspirations, group identities, and cultural values. Their images are thus important

[102] *Id.* An interesting side issue to consider is how Michael Jordan's shoes are a much less obvious means of evocation than many other means putting aside any invocation of Jordan's name or any of the text in the message; Jordan was effectively invoked through a pair of sports shoes with his number. Does this grant a monopoly on this sport plus shoe plus number combination? Potentially yes.
[103] *See Jordan v. Jewel*, 743 F.3d 509 at 518-21.
[104] *Id. at* 518.
[105] *Id. at* 518-19.
[106] *Id.*
[107] *See* U.S. v. Benson, 561 F.3d 718, 725 (7th Cir. 2009).
[108] *See Jordan v. Jewel*, 743 F.3d 509 at 521.

> expressive and communicative resources: the peculiar, yet familiar idiom in which we conduct a fair portion of our cultural business and everyday conversation.[109]

If lines are drawn too tightly, then access to powerful communicative resources including references to celebrities will be non-existent, on the other hand, if lines are too loosely drawn, then celebrities will not have enough control over their own images and incentives to create will also diminish. Therefore, a balancing is needed.

Another issue underlying commercial speech is that sometimes the court will side step the Central Hudson Test. In his scathing dissent in *White v. Samsung Elec. Am., Inc.* Justice Kozinski wrote: "The Supreme Court didn't set out the *Central Hudson* test for its health" when the Court acknowledged the test in that case but never even applied it.[110] Hence, while commercial speech protection may get recognition at times, this is not the same as application and protection.

Martin Redish and Kelsey Shust raise a host of other key issues and problems pertaining to the rationales underlying commercial speech doctrine under First Amendment jurisprudence in particular they attack analysis based on the speaker's motivation.[111] In their analysis of how the jurisprudence is operating, they note that the "subject or content of the expression in question" is treated as irrelevant to the commercial expression dichotomy drawn by the Supreme Court.[112] Furthermore, they critique and reject the theories and suggestions of Robert Post specifically that -"commercial speech cannot be deemed protected 'public discourse' because it 'should be understood as an effort . . . simply to sell products' and not as an effort 'to engage public opinion'" - and contend that this such line of inquiry is based on "speaker motivation".[113] They argue that analysis premised on "speaker motivation" is "sorely misguided" and rather that "the value of an expression's receipt" is more important.[114]

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[109] *See* Madow, *supra* note 5 at 128; *see also* RICHARD SCHICKEL, INTIMATE STRANGERS: THE CULTURE OF CELEBRITY IN AMERICA 29 (Garden City, N.Y.: Doubleday 1985) (calling celebrities as "chief agents of moral change").

[110] *See* White v. Samsung 989 F.2d 1512, 1520 (Kozinski, J., dissenting); *see infra* Section III C discussing Evocation and Samsung.

[111] *See* Redish & Shust, *supra* note 3 at 1483-88.

[112] *Id. at* 1485-86 ("But if value lies in the receipt, then what possible difference can the speaker's motivation make? Whether the speaker is Mother Theresa, Standard Oil, or Darth Vader, the information and opinion conveyed can play an equally legitimate role in shaping the citizenry's views, thoughts, and positions and, in so doing, further the democratic system's operation and the individual citizens' intellectual growth.").

[113] *Id*. (citing Robert Post *see* Robert C. Post, *The Constitutional Status of Commercial Speech*, 48 UCLA L. REV. 1. 18 (2000).

[114] *Id*. *at* 1485-88.

3. Building a New Test That is More Evenly Balanced to Measure Commercial Exploitation Will Require Recognizing Variation and Overlap of Expressive and Commercial Speech Purposes

This paper does not intend to solve the dilemmas posed here as many have tried already, but rather suggest a direction. There needs to be some test that is capable of digging in to more successfully divide expressive speech from commercial speech both recognizing and considering all manner of mixtures and variation therein. This is no easy task and is plain from the attempts that have already been made, but it is essential to helping find a balance for the tension here.

The interest in protecting the expressive speech should be weighed against the harm or loss done from the commercial exploitation of one's property. The analysis could perhaps be factorial building off the direction of the transformative use test as well as taking some ideas from the other two circuit tests mentioned. The analysis should take into consideration at least the overall context of the misappropriation (whether its art, or history, or communication of ideas, news, etc. to answer the important question of whose and what kind of property are we dealing with), the intent or purpose (how and why is the property we are dealing with being used, whether for commercial transactions and advertising or for expressing ideas or even multiple purposes), and means employed for the exploitation, the results and how damaging the actions actually ended up. Taking into consideration just the intent or purpose is not going to tell the whole story under any framework or analysis. On the other hand, it might not be practically useful to just ignore intent and purpose where it can be established or demonstrated. Motivation can inform on whether the exploitation was with good or ill intentions. However, the value of the speech may have to be divorced from the intentions for purposes of protecting the speech so long as it does not fall within any of the unprotected categories.

The purposes for which the property is being exploited must ultimately be weighed and not simply ignored and this gets right to the heart of the expressive commercial speech dichotomy. Speech purposes can be identified and overlap here or even be ambiguous. In considering the means employed for exploitation, were the means involved in the exploitation very minimal, or rather extreme; this would involve considering what elements were taken from the original image literally, versus what was combined and synthesized with newly created elements – the degree of copying, the relevance of the elements to evoking the image or likeness in question. Furthermore, it should be factored in whether a reasonable person would intelligibly and reasonably find the usage to evoke the particular person whose identity has been infringed.

Considering the means employed will also lead to finally consider how much property exploitation could have reasonably been causally expected. The potential for any alternative means might also be considered including whether the content of the expression is perhaps so tightly coupled with the means of saying it that it would be inseparable and practically impossible to express in any other way for instance. For example, in making a joke or parody, inevitably there must be some kernel of truth that is so inseparable and necessary for the audience to be able to identify who the joke is about.

C. Dangerous Stretching of "Evocation Analysis" Under Samsung – The Problem With "Anything Goes"[115]

Another foreseeable problem and potential area for friction, arises from *White v. Samsung Elec. Am., Inc.* in which Justice Kozinski wrote a lengthy and scathing dissent.[116] This case involved the Plaintiff Vanna White, known for being the hostess of "Wheel of Fortune" and the Defendants Samsung Electronics America, Inc. (Samsung) and David Deutsch Associates, Inc. (Deutsch) Samsung ran some advertisements which Deutsch prepared.[117] The advertisements all followed a similar theme of playing on outrageous hypothetical future outcomes for certain current items from popular culture, the one in question involved Samsung's video-cassette recorders (VCRs).[118] Unable to get Vanna White's permission, they went ahead and ran a commercial using a robot look-alike of Vanna White.[119] The robot resembled White; was dressed up complete with a wig (blond hair), a gown, and jewelry set in front of a game board which closely resembled "Wheel of Fortune".[120] Samsung included the caption "Longest-running game show. 2012 A.D." – they were trying to convey that their products would still be around in the twenty-first century in a humorous way.[121] Vanna White had received no compensation for this usage and she gave no consent. Bringing suit in California, White contended that the robot resembled her likeness.[122]

The case has left it unclear whether she has a publicity right in her role and how far evocation can go.[123] Also related is the unique issue of whether publicity rights should vest in fictional characters or roles and not just the actual people portraying them.[124] Ultimately, the court held in favor of White. Even if the case was correctly decided, this case could be problematic for evocation analysis; it will stretch the boundaries of what can be considered to evoke a celebrity to dangerous levels. Justice Kozinski warned in his dissent "Instead of having an exclusive right in her name, likeness, signature or voice, every famous person now has an exclusive right to anything that reminds the viewer of her."[125] This case is arguably taking the field one step closer to granting an absolute right of protection for anything under the sun that would evoke someone's identity or persona. An absolute right of protection would be dangerous and stifle the public domain, other

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[115] Just like the title of a famous Cole Porter song, literally "Anything Goes" in terms of what is considered to evoke one's identity under Samsung. I advocate the creation of the term "Evocation Analysis" to represent this, where courts must now take into consideration more and more kinds of indicia of identity and determine whether and to what degree the identity of a given persona is evoked. Furthermore, I recommend that there needs to be more development in this area to determine whether something reasonably invokes a celebrity's likeness, because the analysis is already implicit in many court decisions, and it is overdue for some explicit development and refinement. *See also* Franke, *supra* note 22 at 977-79 for a discussion on "Evocation".

[116] White v. Samsung Elecs. Am., Inc., 971 F.2d 1395 (9th Cir. 1992), rehearing denied by White v. Samsung Elecs. Am., Inc., 989 F.2d 1512 (9th Cir. 1993), and cert. denied by Samsung Elecs. Am. Inc. v. White, 508 U.S. 951 (1993).

[117] *Id*. at 1396.

[118] *Id.*

[119] *Id*.

[120] *Id*.

[121] *Id*.

[122] *Id*. at 1397.

[123] *Id*. at 1405; *see also* Halpern, *supra* note 7 at 865.

[124] *See* Dawson, *supra* note 1 (Dawson advocates granting publicity rights in fictional characters to actors portraying the characters to the extent that they are so closely coupled that the character's use evokes the actor's identity).

[125] *See White v. Samsung*, 989 F.2d at 1515 (Kozinski J., dissenting).

opportunities for persona to be developed,[126] and many other communicative and artistic human endeavors. Overextending publicity rights to cover anything under the sun could lead to a slippery slope and open a floodgate of litigation for intentional and accidental uses, many warn of the First Amendment consequences flowing from such expansion of the right of publicity.[127] A point of role monopolization/scarcity/depletion could be reached in which lots of celebrities will be suing other celebrities for infringing on their likeness or roles, or borrowed similarities, furthermore this could become compounded by issues from survivability.

Dawn Dawson points out the fears of some including Justice Kozinski and Maddow that placing into the hands of celebrities' exclusive control of identity through the Right of Publicity will impoverish the public domain and shift the balance against the public and in favor of individuals.[128] In *White v. Samsung* Justice Kozinski elaborates:

> The First Amendment is . . . about protecting the free development of our national culture. Parody, humor, irreverence are all vital components of the marketplace of ideas. The last thing we need, the last thing the First Amendment will tolerate, is a law that lets public figures keep people from mocking them, or from 'evok[ing]' their images in the mind of the public.[129]

Even Justice Alarcon – concurring and dissenting in part - said the only thing that would lead the audience to think of White, was the imitation of the "Wheel of Fortune" set, and that "blond hair", a "gown", and "jewelry" are attributes shared by many women and common among other game show hostesses.[130] Under this kind of reasoning, just change a few of the artistic and expressive elements in this or any advertisement, even just one, and it could impact the outcome. To entertain this line of inquiry for a moment, perhaps a fine line is indeed being danced around and trodden on behind the scenes; soon the courts may be assuming the roles of art critics and publicity right owners assuming the roles of censorship kings. Parody and mockery form an important safety valve for society.[131]

The subjectivity, interchangeability, fluidity, and association garnering aspects of identity may also pose problems for evocation analysis. People and identity can change over time and indeed celebrities and individuals change their names, change their appearance and even their roles and the things that the public associates with celebrities may change over time.

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[126] *Id. at* 1517.
[127] *See e.g.* Linda, *supra* note 3; *see also* Siderits, *supra* note 3.
[128] *See* Dawson, *supra* note 1 at at 647.
[129] *See White v. Samsung*, 989 F.2d at 1519 (Kozinski J., dissenting).
[130] *See White v. Samsung*, 971 F.2d at 1405 (Alarcon J., partial dissent).
[131] *See White v. Samsung*, 989 F.2d at 1517 (Kozinski J., dissenting) ("The public will be robbed of parodies of celebrities, and our culture will be deprived of the valuable safety valve that parody and mockery create").

D. Requiring Permission for Free Speech and Encouraging Expressive and Stylistic Confinement

There is some pushback and criticism against the transformative use test in some of its more recent applications emerging from the chaos left by *Zacchini*. For instance, *Keller v. Elec. Arts Inc.* and *Hart v. Elec. Arts Inc.* in which college athletes sued EA for using their likeness in video games through the use of digital avatars.[132] Thomas Kadri raises some interest arguments and criticism including that artists should not be confined in their expressive tools to just parody and satire, but should be allowed to use "alternative means" such as realism to depict the content of their work but currently under the transformative use test, an artist is forced to obtain permission.[133] For example, if a video game company like EA wants to make a video game of the football players, it would have to approach several thousand athletes in NCAA division I football and request a license.[134] Every athlete would have the power to refuse to be part of the work, or could condition his inclusion on distorting reality in his favor.[135]

1. Imitation of the Human Voice

A person's voice can be the sole thing necessary to identify or evoke a person's identity. *Midler v. Ford Motor Co.* created a tort for misappropriating a singer's voice, the three elements of a Midler tort are deliberate misappropriation of 1) a voice that is 2) distinctive, and 3) widely known.[136] The car company Ford in conjunction with Young and Rubicam, wanted to run a commercial advertisement with a recording of Bette Midler singing the song "Do You Want To Dance" but she refused permission through her agent.[137] They decided to go ahead and ended up hiring her backup singer to do the commercial instead and told her backup singer to "sound as much as possible like the Bette Midler record."[138] The appellate court reversed the district court and found in favor of Midler – that her voice was protected against unauthorized uses that are without permission or consent.[139] *Waits v. Frito-Lay, Inc.* similarly involved a sound-alike used in an advertising campaign against the artist's wishes.[140]

These cases are not about infringing of copyright in a musical composition - rather they are about imitating the distinctive voice which is not the same thing as imitating style. The Ninth Circuit in *Midler v. Ford* noted that "[m]ere imitation of a recorded performance would not constitute a copyright infringement even where one performer deliberately sets out to simulate another's performance as exactly as possible."[141] Style is "how the music is delivered, how the

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[132] Keller v. Elec. Arts Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litig.), 724 F.3d 1268 (3rd Cir. 2013); see also Hart v. Elec. Arts, Inc., 717 F.3d 141 (3rd Cir. 2013).
[133] *See* Kadri, *supra* note 42 at 1519 (arguing for creation of a bright-line test to ensure more protection for the creators of expressive works).
[134] *Id.* at 1527.
[135] *Id.*
[136] Midler v. Ford Motor Co., 849 F.2d 460, 463 (9th Circ. 1988).
[137] *Id.* at 461-463.
[138] *Id.*
[139] *Id.*
[140] Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992).
[141] *See Midler v. Ford*, at 462 ("A voice is not copyrightable. The sounds are not 'fixed.' What is put forward as protectable here is more personal than any work of authorship.").

words of a song are expressed. Style includes mood, phrasing, and timing. . . . Style is not subject to ownership."[142] Voice is about identity and is as personal, individual, and distinctive as each person's face.[143] Imitation does not necessarily condemn the work to liability, what's critical is whether the audience is under the belief or illusion that it's actually the singer in question performing the work and not an imitator. In a sense, this could be nearly analogous to impersonation or high jacking of another's voice; "To impersonate her voice is to pirate her identity."[144] Thus there is a somewhat ambiguous and unresolved clash between misappropriating the embodiment of one's identity through their voice and mere musical imitation of their voice. The distinction and framework for distinguishing between hijacking one's voice and merely imitating it, is left vague although some aspects can clearly be ruled out including literally copying musical style. Vocal misappropriation must include to a large extent imitation of one's voice, but misappropriation must also involve something more and something worse than mere imitation, and this something more is where much of the ambiguity lies. To put it another way, courts are being asked to draw the lines between mere imitation in the sense of borrowing musical elements from another's voice versus vocal imitation crossing the threshold borrowing and outright stealing one's identity, and minus any demonstrable intent as was clear in these cases, these are very hard lines to draw because it is art and music and subjectivity that is involved.

2. Facial Indicia and Photographs

One day, in the not so far future, issues relating to facial indicia could literally blow up in our faces. What could be more uniquely identifying and intimately belonging to a person's identity as a human than their own face? The court in *Edison v. Edison Polyform Mfg.* said that "[I]f a man's name be his own property . . . it is difficult to understand why the peculiar cast of one's features is not also one's property, and why its pecuniary value, if it has one, does not belong to its owner, rather than to the person seeking to make an unauthorized use of it."[145] But with the advent of technology, digital avatars, and morphing techniques for instance, will it be possible perhaps even desirable to secure property in one's peculiar and pecuniary facial features?

Also, with technological increase, the walls between people's private and public lives are breaking down. If a person's photo is taken in a public place, then the first three privacy torts that Dean Prosser lays out, are not actually applicable, however the fourth one which became publicity rights may save face here one day.[146] Of course much will depend on how the photo is used. Currently publicity law cannot help as there is typically little to no commercial value for most normal people who are non-public figures and non-celebrities, though perhaps arguments about aggregate value could be made in the context of class action. Generally, once it's out there in the public sphere whether it's a public beach or shopping mall, barring any reasonable expectations of privacy or demonstration of injury, exploitation or false light etc., its fair game. But there are proposals going forward including tort reform, contractually vesting ownership of the photo with

[142] Language from proposed jury instruction discussed in Waits v. Frito-Lay, 978 F.2d 1093 at n. 2, also available at Http://law2.umkc.edu/faculty/projects/ftrials/communications/waits.html (last visited April 30, 2017).
[143] *Midler v. Ford* at 463.
[144] *Id.*
[145] Edison v. Edison Polyform Mfg., 67 A. 392 (N.J. Ch. 1907).
[146] *See* Note, *In the Face of Danger: Facial Recognition and the Limits of Privacy Law*, 120 HARV. L. REV. 1870 (2007).

the subject so that the photographer must bargain for its use, and congressional intervention and regulation to provide people with an opt-out from companies that provide facial indexing and search services.[147] There are certainly privacy concerns at stake, but there are also First Amendment concerns including the free flow of information, social and artistic commentary which could be impeded if too much control is concentrated on restricting the ability to disseminate photographs. These must be balanced.

Consider the case *Hoffman v. Capital Cities/ABC, Inc.*, in which Los Angeles Magazine ("LAM") published photographs of actors some deceased some still living, wearing Spring 1997 fashions by using computer technology to alter famous film stills.[148] LAM artists used a famous still photo from the film "Tootsie" in which Dustin Hoffman who was portraying a male actor dressing the part of a woman in order to get a part on a television soap opera, wore a "long-sleeved sequined evening dress and high heels, then replaced his body with the image of a male model wearing a different evening dress and high heels.[149] His head remained as in the original, however now his body was replaced by "a male model in the same pose, wearing a spaghetti-strapped, cream-colored, silk evening dress and high-heeled sandals."[150] While the district court ruled this an exploitative commercial use, the Ninth Circuit reversed and held this to be not commercial speech and under First Amendment Protection as there was no showing of malice.[151] The Ninth Circuit found this to be a "combination of fashion photography, humor, and visual and verbal editorial comment on classic films and famous actors" and not pure commercial speech; any commercial aspects here were found to be "inextricably entwined" with the expressive elements.[152]

E. Creating a Federal Right of Publicity is One Potential Avenue to Smooth out the Friction

Perhaps the field is due a major overhaul, some have proposed moving toward a single federal right of publicity as one possible solution to end the uncertainty.[153] This would have the potential to create a baseline and standard against which state common law could even balance or enhance. There exists great potential to make the system more stable, predictable, uniform, less arbitrary, and less full of inconsistent tests for the courts to pick through. However, advocates for a new more unitary federal right of publicity should consider how to counter any drawbacks of such a system including the loss of flexibility and options that comes with a buffet of tests which arise to deal with situations that may not necessarily fit into neat categories. One single federal right of publicity may not truly solve the problem any more than the existing tests if the underlying friction is not properly balanced and if there is still substantive vagueness within this new federal right of publicity. After all, the existing tests came about for a reason. Many of the problems giving rise to inconsistencies in publicity rights operate along different contexts that may not necessarily mesh. Furthermore, First Amendment law is full of so many tests precisely because it deals with

[147] *Id*.
[148] Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180 (9th Cir. 2001).
[149] Jennifer L. Koehler, *Comedy III Productions, Inc. v. Gary Saderup, Inc.: Finding a Balance between the Right of Publicity and the First Amendment Right of Freedom of Speech*, 18 SANTA CLARA HIGH TECH. L.J. 161, 169 (2001), available at http://digitalcommons.law.scu.edu/chtlj/vol18/iss1/6; *Hoffman v. Capital*, 255 F.3d 1180 at 1182-83.
[150] *Hoffman v. Capital*, 255 F.3d 1180 at 1182-83.
[151] *Id. at* 1185-89.
[152] *Id. at* 1185.
[153] *See* Rooney, *supra* note 56 at 958.

multifaceted issues that are at times disparate, and at other times overlapping.[154] Moreover, an approach with one single test may hold good potential but alone may not be sufficient to solve this riddle. Perhaps merging the existing tests together and using a sorting of the wheat from the chaff kind of approach whereby only the best qualities of the existing tests are kept, and the ambiguities or weaknesses are worked out, could bring things one step closer to developing a workable one test federal right of publicity solution.

IV. CONCLUSION

Fundamentally, the Right of Publicity grants an exclusive right of property ownership in one's image, name or likeness; and the ability to gain, benefit, or use that property whether it is through direct control, or licensing, or assigning away one's rights. This would apply whether it's a widely-recognized celebrity or the most private individual even though these rights have developed primarily to protect the property rights of those of renown. However, any right that is granted in this arena is going to come at the cost of another's rights in free speech or expression. There can be both good and bad dimensions to this. There are clearly many instances where appropriation of identity is harmful and wrong particularly concerning commercial exploitation. There is strong grounding for preventing, deterring, and punishing such harmful uses. Invading and exploiting one's identity is still wrong even without profit as the primary motive. Through all potential scenarios, a careful balancing must be made to appropriately narrow publicity protection where First Amendment Freedoms are warranted or worthy of more protection than the Rights vested in Publicity. The current practice in this area is unsettled and still under development with a few prominent tests emerging. The outer limits are under defined. Currently the field could use an overhaul and one possible solution is the creation of a federal statute, but more importantly the law must be crafted with a keen eye to balance the friction between First Amendment Freedoms and Publicity Rights.

[154] For an example of all the First Amendment tests out there, consider the variety of tests related to the free exercise of religion and used in establishment clause cases: including the establishment clause test, the lemon test, the endorsement test, and the coercion test, each test crafted for and fitting different contexts of a larger multifaceted issue.